



UNITED STATES PATENT AND TRADEMARK OFFICE

mn

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,968	01/23/2004	Jeffrey C. Smith	127-0006-1	7903

22120 7590 07/25/2007
ZAGORIN O'BRIEN GRAHAM LLP
7600B NORTH CAPITAL OF TEXAS HIGHWAY
SUITE 350
AUSTIN, TX 78731

EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
----------	--------------

2135

MAIL DATE	DELIVERY MODE
-----------	---------------

07/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,968	Applicant(s) SMITH ET AL.	
	Examiner HOSUK SONG	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 12-39 is/are ~~withdrawn from consideration~~ ^{canceled}.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 40-48 and 52-61 is/are rejected.
- 7) ☒ Claim(s) 49-51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10763968</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2135

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11,40-48,52-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Dykstra et al.(US 5,611,052).

Claim 11: Dykstra disclose responsive to identification of the first user by the second user and prior to creation of an account for the first user in(col.4,lines 30-35), sending a first message to the first user in a session with the first user in response to the message, receiving user account information from the first user(col.7,lines 14-40). Dykstra disclose sending a second message to the first user wherein the second message informs the first user regarding creation of a user account in accordance with the received user account information in (col.4,lines 49-66).

Claim 40: Dykstra disclose the first message includes a first resource locator by which the first user initiates the session in (fig.2A).

Claim 41: Dykstra disclose authenticating identity of the first user based at least in part on the received user account information and thereafter initiating the data transaction in (col.2,lines 17-24).

Claim 42: Dykstra disclose wherein the second message includes a second resource locator by which the first user may retrieve information of the data transaction in (col.4,lines 49-66).

Claims 43-48: Dykstra disclose transmitting a first message to the recipient, the first message including a recipient specific resource locator and responsive to a retrieval using the recipient-specific resource locator (col.4,lines 30-35; col.7,lines 14-40) , authenticating identity of the recipient and

Art Unit: 2135

thereafter supplying the private information to the recipient in (col.2,lines 17-24;col.4,lines 49-66; col.5,lines 19-38).

Claim 52: Dykstra disclose wherein the criterion specifies authentication information known, or separately communicated to, the intended recipient but generally unknown to others and wherein the authenticating includes verifying information received from the recipient against the authentication information received from the sender in (col.2,lines 17-24;col.4,lines 49-66;col.5,lines 19-38).

Claim 53: Dykstra disclose first message is an e-mail message wherein the private information includes a document encoding and wherein the resource locator includes an URL and the authenticating is performed using a dialog that is at least initiated using content supplied to the recipient based on the URL in (fig.1).

Claims 54-59: Dykstra disclose a first functional sequence executable in a secure messaging system to transmit a first message to a recipient not previously enrolled in the secure messaging system, wherein the first message includes a recipient specific resource locator in (col.4,lines 30-35). Dykstra disclose functional sequence executable in the secure messaging system to service a session initiated by the recipient using the recipient specific resource locator and to authenticate identity of the recipient in (col.2,lines 17-24;col.7,lines 14-40). Dykstra disclose a third functional sequence executable in the secure messaging system to supply the private information after successful authentication of the recipient in (col.4,lines 49-66; col.5,lines 19-38).

Claims 60-61: Dykstra disclose receiving from the sender both the private information and at least once criterion for use in authenticating identity of the recipient if the recipient has not previously been enrolled in the messaging system in (col.4,lines 30-35). Dykstra disclose transmitting a first message to the recipient, the first message including a recipient specific resource locator and in a session initiated by the recipient using the recipient-specific resource locator, authenticating identity of the recipient and thereafter supplying the private information to the recipient in (col.4,lines 49-66; col.5,lines 19-38).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 54-59 are not statutory, directed to software, per se, lacking storage on a medium which enables any underlying functionality to occur.

Allowable Subject Matter

Claims 49-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

Applicant's submission of an IDS on 5/18/07 prompted new grounds of rejection. New rejection is presented above.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 5/18/07 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing

Art Unit: 2135

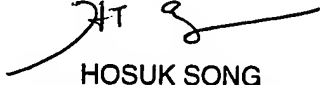
date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOSUK SONG whose telephone number is 5712723857. The examiner can normally be reached on mon-fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM VU can be reached on 5712723859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HOSUK SONG
PRIMARY EXAMINER